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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 266

JOHNS-MANVILLE CORPORATION, *Petitioner*,

v.

ITALIT, INC., *Respondent*.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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ITALIT, INC., *Respondent*.

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Petitioner, Johns-Manville Corporation, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit, entered in the above-entitled case on April 16, 1964.

THE OPINIONS BELOW

The opinion of the district court is reported in 209 F. Supp. 798, and the opinion of the court of appeals is reported in 331 F.2d 663. Both opinions are reproduced in full in the appendix to this petition.

JURISDICTION

The judgment of the Court of Appeals for the Fifth Circuit was entered on April 16, 1964. The jurisdiction of this Court is invoked under Title 28 U.S.C., Section 1254(1).

QUESTIONS PRESENTED FOR REVIEW

The questions concern Rule 52(a) of the Federal Rules of Civil Procedure and its relation to due process of law. The trial court heard conflicting expert and other testimony and considered scientific documentary evidence with respect to disputed fact issues involving the physical properties and functions of a rubber sealing ring or gasket. Its decision in favor of petitioner (plaintiff below) was based upon detailed findings of subsidiary and ultimate fact drawn from, and in large part literally referring to, such testimony and documentary evidence. These findings show that the trial court had weighed the qualifications and credibility of the witnesses. The decisions of this Court establish the principle that findings of fact may be set aside as "clearly erroneous" under Rule 52(a) only if *after a specific consideration of the entire evidence* they are found to be either:

(a) not supported by substantial evidence, or

(b) even though supported by substantial evidence, contrary to the clear weight of the evidence.

In the present case, the court of appeals set aside findings of fact without a single reference to the testimony or documentary evidence, to the qualifications or credibility of the witnesses, or to the findings of the trial

court. Therefore, the questions presented for review are:

1. When a court of appeals ignores or violates the requirements of Rule 52(a) and thereby destroys a valuable property right, is the owner of the right "deprived of . . . property without due process of law"?

2. Does the sound administration of justice require, in the application of Rule 52(a), that when a trial court's detailed findings of scientific fact are set aside by a reviewing court, the reviewing court must review the entire evidence, must specifically compare the findings with the evidence and must demonstrate in what respect any findings set aside are not supported by substantial evidence or are contrary to the clear weight of the evidence?

3. May a court of appeals set aside a trial court's findings of fact for the reason that "the district court entered findings of fact and conclusions of law which, except for some minor changes, had been prepared by counsel . . ."?

CONSTITUTIONAL PROVISION INVOLVED

"No person shall . . . be deprived of . . . property, without due process of law: . . .". Constitution of the United States of America, Fifth Amendment.

FEDERAL RULE OF CIVIL PROCEDURE INVOLVED

"Rule 52.

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing

interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses . . .".

STATEMENT OF THE CASE

Petitioner brought action against respondent in May 1960 for patent infringement, in the U. S. District Court for the Southern District of Florida. Jurisdiction was based on Title 28 U.S.C. Sections 1338(a) and 1400(b), and also on Title 35 U.S.C. Section 281. The case was tried August 14, 15 and 16, 1961, before Emett C. Choate, District Judge, without a jury. At the trial, five witnesses including an expert testified on behalf of petitioner; four witnesses including an expert testified on behalf of respondent, and a total of 185 exhibits were introduced.

An interlocutory judgment was entered, adjudging petitioner's patent valid and infringed. The opinion of the district court is reproduced herein as Appendix A. The findings of the court are detailed, replete with references to the evidence, and many of them refer to the testimony and credibility of the witnesses at the trial. The relative qualifications of the expert witnesses were an important element in judging the facts. The trial court made twelve detailed subsidiary findings of scientific fact, to the effect that petitioner's patent was literally infringed by respondent's device, and also that respondent's device was the full equivalent of the patented device "as it performs substan-

tially the same functions in substantially the same way to obtain the same results". (Appendix A, Finding 36)

At the trial respondent offered no evidence whatever on the issue of equivalence. In its brief on appeal respondent declined to compare any of the trial court's findings with the evidence. Its presentation to the court of appeals consisted of a reiteration of statements of fact, without any reference to the record, these statements already having been made to and rejected by the trial court on the basis of the testimony and other evidence.

On appeal, the court of appeals affirmed the findings and conclusions on the issue of validity, specifically stating that the findings on this issue were not "clearly erroneous". The opinion is reproduced herein as Appendix B.

The court of appeals reversed the judgment below on the issue of infringement and this petition is directed generally to that section of the court of appeals opinion in which this issue is discussed; namely, Appendix B pages 6 through 12. *In these pages there is not a single reference to any finding of fact by the trial judge, to the evidence or to the issue of equivalence.* There is no statement that the court of appeals had reviewed the entire evidence, and nothing in the decision supports an assumption that the entire evidence was reviewed.

In its opinion (Appendix B, pages 6-10) the court of appeals discusses the prosecution history of the patent in suit, apparently to support its conclusion (Appendix B, pages 9, 10) as to the scope of the claims. For purposes of this petition, petitioner accepts the

conclusion that the claims in suit are restricted to constructions including sealing rings or gaskets which function on the "O-ring principle".

This petition is specifically directed to the last seven paragraphs of the opinion (Appendix B, pages 10-12), which contain statements of *fact* apparently made to support the conclusion that respondent's gasket does not function on the "O-ring principle" and, hence, that respondent's coupling falls outside the scope of the claims in suit. It should be noted that the portions of the opinion about which petitioner complains relate entirely to *subsidiary fact issues*—issues regarding the physical properties and mode of functioning of a specific gasket. The trial court made detailed findings of fact, with references to the evidence, on each of these issues, yet the court of appeals did not review these findings or compare them with the evidence. It did not at any point in these paragraphs, or elsewhere in the opinion, refer to these findings or make any attempt to show that its contrary statements of fact were supported by the evidence. It did not state anywhere in its opinion that the findings of fact of the trial judge were not supported by substantial evidence, or were contrary to the clear weight of the evidence. Instead it merely quoted or paraphrased wholly unsupported statements from respondent's brief below, which were adopted as the substituted judgment of the court of appeals.

The opinion of the court of appeals not only fails to state explicitly that it assessed the record, but it indicates that the record was not considered at all. As demonstrated by the brief examples in Appendix C to this petition, the statements of the court of appeals are clearly contrary to the facts established by the

testimony and documentary evidence. While the correctness of these fact statements by the court of appeals is not presented for direct review in this petition, petitioner submits that the absence of evidentiary support for them as clearly demonstrated in Appendix C, shows that no fair assessment of the record was attempted.

At no point in its entire opinion does the court of appeals provide a clearcut reason for its departure from the standard of review required by Rule 52(a). There is one statement in the opinion which may provide a clue to the reason. On pages 2 and 3 of its opinion (Appendix B), the court of appeals stated:

> "The district court entered findings of fact and conclusions of law which, *except for some minor changes*, had been prepared by counsel for Johns-Manville". (emphasis added)

The decisions referred to in footnote 4 of the opinion indicate that findings of fact prepared by counsel are governed by Rule 52(a), but may be given less weight than findings prepared by the trial judge. In this case reference to counsel's participation in the preparation of the findings, and the failure of the court of appeals to follow the mandates of this Court relative to Rule 52(a), implies that the court of appeals felt it could reverse free of the "clearly erroneous" doctrine. If so, the court committed an error of law.

The findings were prepared as described below.

On February 15, 1962, counsel for petitioner was advised that the trial court had found the patent in suit to be valid and infringed. Counsel was requested to propose findings of fact and conclusions of law con-

sistent with the evidence produced by the testimony and documents at the trial.

Twelve days later counsel for petitioner presented to the trial court, for his consideration, 49 proposed findings and 17 proposed conclusions, *noting and certifying that copies of the proposed findings and conclusions had been served on counsel for respondent.* The letter accompanying the proposed findings and conclusions was a part of the record on appeal, and is reproduced as Appendix D to this petition.

In the ensuing six weeks the trial judge reviewed the proposed findings and conclusions, deleted two proposed findings altogether, made thirty-three changes in thirteen other proposed findings, deleted one proposed conclusion and revised two others. *Neither during this period nor at any other time did respondent offer any objections, comments or proposals of its own.* The trial judge made changes, corrections, additions and deletions on a copy of the proposed findings and conclusions, which was then returned to counsel for petitioner with a request that it be retyped in such form. This was done, and the papers were delivered to the court with a covering letter dated April 9, 1962, which was also a part of the record on appeal and is reproduced as Appendix E to this petition.

No motion under Rule 52(b) to amend the findings or to make additional findings, or any motion for a new trial under Rule 59, was made by respondent. Instead, respondent acquiesced without criticism in the fact findings adopted by the court and simply filed an appeal from the judgment based thereon.

REASONS FOR GRANTING THE WRIT

QUESTION ONE

When a Court of Appeals Ignores or Violates the Requirements of Rule 52(a) and Thereby Destroys a Valuable Property Right, Is the Owner of the Right "Deprived of . . . Property Without Due Process of Law"?

Pursuant to the authority granted to it in 28 U.S.C. 2071 and 2072, this Court prescribed the Federal Rules of Civil Procedure, including Rule 52(a). The third sentence of that rule, which relates to findings of fact by trial judges, is in the form of a commandment to reviewing courts—it says "*shall not*". The rule is mandatory, not merely permissive. The fourth paragraph of 28 U.S.C. 2072 states with respect to the Federal Rules of Civil Procedure:

> "All laws in conflict with such rules shall be of no further force and effect after such rules have taken effect. Nothing in this title anything therein to the contrary notwithstanding, shall in any way limit, supersede, or repeal any such rules heretofore prescribed by the Supreme Court."

It is apparent that Rule 52(a) has the force of law. This Court has stated with respect to this rule:

> "It is not enough that we might give the facts another construction, resolve the ambiguities differently, and find a more sinister cast to actions which the District Court apparently deemed innocent. See United States v. Yellow Cab Co. 338 US 338, 342, ante, 150, 133, 70 S Ct 177; United States v. United States Gypsum Co. 333 US 364, 394, 395, 92 L ed 746, 765, 766, 68 S Ct 525. We are not given those choices, because our mandate is not to set aside findings of fact 'unless clearly erroneous.'" *United States v. National Association of Real Estate Boards et al*, 339 US 485, 495, 94 L ed 1007, 1016, 70 S Ct 711.

When this mandate is ignored or violated in a decision which destroys or limits a valuable property right, the owner of that right is divested of property without due process of law. It has repeatedly been held that the Fifth Amendment of the Constitution requires that:

> "To devest an individual of his property against his consent, every substantial requisite of the law must be shown to have been complied with." *Ronkendorff* v. *Taylor's Lessee*, 29 US (4 Pet.) 349, 359, 7 L ed 882, 885.

The substantial requisites of the third sentence of Rule 52(a) depend largely on the meaning of "clearly erroneous". These words have been interpreted many times. The decision of this Court which permits reviewing courts the greatest latitude is *United States* v. *United States Gypsum Company*, 333 US 364, 394, 92 L ed 746, 765, 68 S Ct 525, where this Court stated that:

> "* * * findings of fact in actions tried without a jury 'shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' It was intended, in all actions tried upon the facts without a jury, to make applicable the then prevailing equity practice. Since judicial review of findings of trial courts does not have the statutory or constitutional limitations on judicial review of findings by administrative agencies or by a jury, this Court may reverse findings of fact by a trial court where 'clearly erroneous.' The practice in equity prior to the present Rules of Civil Procedure was that the findings of the trial court, when dependent upon oral testimony where the candor and credibility of the witnesses would best be judged, had great weight

with the appellate court. The findings were never conclusive, however. A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court *on the entire evidence* is left with the definite and firm conviction that a mistake has been committed." (emphasis added)

The Court then proceeded to demonstrate how the "clearly erroneous" question is to be determined in practice. It considered *the entire evidence* and compared the documentary evidence with the oral testimony before the Court. The Court then stated (333 US 396, 92 L ed 766):

> "Where such testimony is in conflict with contemporaneous documents we can give it little *weight*. . . ." (emphasis added)

The Gypsum case establishes the principle that before a reviewing court may be "left with a definite and firm conviction that mistake has been committed" and, hence, justified in setting aside fact findings as "clearly erroneous", it must have *reviewed* "the entire evidence", must have *determined* if the findings are supported by substantial evidence and, if so, have *demonstrated* that the findings are nevertheless contrary to the clear weight of the evidence. Barron & Holtzoff, Federal Practice and Procedure, Volume 2B (Wright ed. 1961), § 1135, page 550, states the principle as follows:

> "If, however, the findings of fact are supported by substantial evidence, and are not against the clear weight of the evidence the appellate court may not overturn them."

In other cases, the Fifth Circuit Court of Appeals has recognized its duty to test the record for evidence

supporting the findings below and to accept them unless clearly erroneous. *Kwong* v. *Occidental Life Insurance Co. of California*, 273 F. 2d 691, 695. It has recognized that if fair and impartial men might reasonably draw the same or different inferences from evidence presented to a trial court, findings of fact based on such evidence shall not be set aside, and that "it is not for the appellate court to substitute its judgement on disputed issues of fact for that of the trial court where there is substantial credible evidence to support the finding." *Shepherd* v. *Mahannah*, 220 F. 2d 732, 739.

The importance of Rule 52(a) to the proper administration of justice, in cases such as the one at bar, has been underlined by this Court itself, in *Graver Tank & Manufacturing Co., Inc.* v. *Linde Air Products Company*, 336 US 271, 274, 93 L ed 672, 676, 69 S Ct 535, this Court stated:

> "Rule 52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' *To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations.*" (emphasis added)

Under all of the authorities referred to above, the requisites of Rule 52(a) are that detailed findings of scientific fact by a trial court *shall not* be set aside by a reviewing court unless that court upon a comparison of the findings with the entire evidence *demonstrates* that the findings either (a) are not supported by sub-

stantial evidence or (b) even though supported by substantial evidence are contrary to the clear weight of the evidence.

In the case at bar the requisites of Rule 52(a) were not complied with by the court of appeals in this case. It placed no burden on respondent or itself to *demonstrate* that the findings of fact in this case were not supported by substantial evidence or were contrary to the clear weight of the evidence. It did not state that it had reviewed the entire evidence, and nothing in the decision supports an assumption that the entire evidence was reviewed. Obviously, the evidence was not evaluated in connection with the trial court's findings of fact; there is no holding that the trial court's findings of fact are not supported by substantial evidence, nor any indication that even a single finding is unsupported by substantial evidence. Nothing is said about the weight of the evidence, nothing is said about the standard of review applied. A court of appeals decision which ignores the findings of the trial court, which ignores the evidence, which ignores Rules 52(a), which does not give regard to the opportunity of the trial court to judge of the credibility of the witnesses, and which ignores such special circumstances as deliberate copying (Appendix A, Finding 47), obviously represents a gross misapplication of the proper standard of review.

Respondent contended below that the court of appeals was not bound by Rule 52(a) because infringement and equivalence are ultimate facts and therefore in the nature of questions of law. When, however, determination of infringement depends upon disputed fact issues such as the physicial properties and mode of functioning of an element of a device, infringement

is definitely a question of fact, not a question of law, and is fully subject to the clearly erroneous rule. *Coupe et al* v. *Royer et al*, 155 US 565, 39 L ed 263, 15 S Ct 199; *United States* v. *Esnault-Pelterie*, 303 US 26, 82 L ed 625, 58 S Ct 412. Similarly, equivalence is a fact question clearly governed by Rule 52(a):

> "A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous." *Graver Tank & Manufacturing Company, Inc. et al* v. *Linde Air Products Company*, 339 US 605, 609, 94 L ed 1097, 1103, 70 S Ct 854.

Respondent urged the court of appeals to consider the issues of infringement and equivalence in this case "free of the clearly erroneous rule" or "subject to review free of the restraining impact of the so-called clearly erroneous rule", on the authority of its earlier decisions in *Industrial Instrument Corporation* v. *Foxboro Company*, 307 F.2d 783 (1962) and *Galena Oaks Corporation* v. *Scofield*, 218 F.2d 217 (1954). If this is what the court of appeals did, and such appears to be the case, the court erred in law, and its decision should be reviewed and reversed by this Court.

We submit that the decision of the court of appeals was completely arbitrary and capricious, and deprived petitioner of property without due process of law.

QUESTION TWO

Does the Sound Administration of Justice Require in the Application of Rule 52(a), That When a Trial Court's Detailed Findings of Scientific Fact Are Set Aside By a Reviewing Court, the Reviewing Court Must Review the Entire Evidence, must Specifically Compare the Findings With the Evidence, and Must Demonstrate in What Respect Any Findings set Aside Are Not Supported By Substantial Evidence or Are Contrary to the Clear Weight of the Evidence?

The requisites of Rule 52(a) are clearly established by the authorities discussed above and there should be no question about the propriety, in the interest of the sound administration of justice, of demanding that these requisites be fully complied with in every case. The reasons for strict enforcement of Rule 52(a), and the exercise by this Court of its supervisory authority in cases where that rule is violated, were summed up by Judge Sanborn of the Eighth Circuit Court of Appeals in the following words:

> "The existence of any doubt as to whether the trial court or this Court is the ultimate trier of fact issues in nonjury cases is, we think, detrimental to the orderly administration of justice, impairs the confidence of litigants and the public in the decisions of the district courts, and multiplies the number of appeals in such cases." *Poudergrass et al* v. *New York Life Insurance Company et al*, CA 8 (1950), 181 F.2d 136, 138.

Further, any doubt as to which court is the ultimate trier of fact issues reduces the trial procedure to a farce. There is no function to be served by a trial court if the testimony and evidence and full arguments on the fact issues there presented are to be completely ignored by a court of appeals, which may substitute its own judgment of the facts for the findings of the trial

court. Not only is the confidence of litigants in decisions of the district courts impaired, their confidence in the entire judicial system is severely shaken. If a court of appeals is free to do what the Fifth Circuit Court of Appeals has done in this case, and if such practice is generally adopted, no litigation will ever end before it reaches this Court or the litigants run out of money.

The Fifth Circuit Court of Appeals has previously held it to be "well settled that, in order for a reviewing court to set aside findings of fact by a trial court sitting without a jury, it must be clearly *demonstrated* that such findings are without adequate evidentiary support in the record, or were induced by an erroneous view of the law, and the burden of showing that the findings are 'clearly erroneous' is on the one attacking them." (emphasis added) *Cedillo* v. *Standard Oil Company of Texas*, 291 F. 2d 246, 248. In its appeal to the court of appeals, respondent declined to accept this burden; the trial court findings were deliberately ignored. In such circumstances, the sound administration of justice should have led the court of appeals to dismiss the appeal summarily, and affirm the district court.

Although this petition arises out of a patent infringement action, it raises basic issues of proper review of district court decisions. It is essential in the interest of sound administration of justice that the rules of law applicable to appellate review be stated with such clarity and conciseness that appellate courts will avoid mistakes which tend to increase the number of appeals and diminish respect for our judicial system as a whole.

QUESTION THREE

May a Court of Appeals Set Aside a Trial Court's Findings of Fact for the Reason That "the District Court Entered Findings of Fact and Conclusions of Law Which, Except for Some Minor Changes, Had Been Prepared By Counsel . . ."?

In its decision, the court of appeals did not state that it was setting aside and reversing the fact findings of the district court "free of the clearly erroneous rule", nor that it was reversing the findings as "clearly erroneous". The court of appeals did state (Appendix B, pages 2, 3):

> "The district court entered findings of fact and conclusions of law which, except for some minor changes, had been prepared by counsel for Johns-Manville."

While the preparation of proposed findings and conclusions by counsel has not been universally approved, it has been recognized to be a practical necessity in many cases. When requested by a court to prepare proposed findings and conclusions for the court's consideration, counsel can hardly refuse. Indeed, some authorities hold that counsel, especially counsel for the prevailing party, *have an obligation* to a busy court in the performance of duty in that regard. Further, counsel should prepare and submit the proposed findings with reasonable promptness. Barron and Holtzoff, Federal Practice and Procedure (Wright ed. 1961) Volume 2B, § 1124, pages 493, 494.

There is no basis in law for disregarding Rule 52(a) on the ground that proposed findings and conclusions were prepared by counsel, at the request of the trial court, and this Court has repeatedly so held. In *United States* v. *El Paso Natural Gas Company*,

US , 12 L ed 2d 12, 17, 84 S Ct , this Court stated:

> "There was a trial and after oral argument the judge announced from the bench that judgment would be for respondents and that he would not write an opinion. He told counsel for respondents 'Prepare the findings and conclusions and judgment.' They obeyed, submitting 130 findings of fact and one conclusion of law, all of which, we are advised, the District Court adopted verbatim. *Those findings, though not the product of the workings of the district judge's mind, are formally his, they are not to be rejected out-of-hand, and they will stand if supported by evidence.*" (emphasis added)

In *United States* v. *Crescent Amusement Company*, 323 US 173, 184, 89 L ed 160, 169, 65 S Ct 254, an objection to findings on the ground they were taken verbatim from a party's brief was similarly treated. The Court said:

> "The defendants finally object to the findings on the ground that they were mainly taken verbatim from the government's brief. The findings leave much to be desired in light of the function of the trial court. See United States v. Forness (CCA 2d) 125 F(2d) 928, 942, 943. *But they are nonetheless the findings of the District Court. And they must stand or fall depending on whether they are supported by evidence. We think they are.*" (emphasis added)

See also *United States* v. *Oregon State Medical Society*, 343 US 326, 331, 96 L ed 978, 983, 72 S Ct 690.

In this case, the findings and conclusions proposed by counsel were not "mechanically adopted" by the trial court. The trial judge reviewed the findings and conclusions, and made numerous changes, corrections, additions and deletions. Nothing was done without the knowledge of respondent; the proposed findings and conclusions were served on counsel for respondent at the same time they were delivered to the trial judge. The proposed findings were replete with references to the testimony and the documentary evidence so that each when reviewed could be carefully checked for support. The findings adopted by the district court truly reflect the workings of his mind, and reveal the steps by which the trial court reached its ultimate conclusion on each factual issue.

If in the present case, the court of appeals set aside the trial court's findings of fact for the reason that proposed findings of fact and conclusions of law were submitted by counsel for the prevailing party, the decision of the court of appeals was clearly erroneous in law, and in conflict with prior decisions of this Court.

CONCLUSION

Complete confidence of litigants and the public in decisions of the district courts, and in the integrity of appellate review, is a matter of the highest public interest. The decision below represents a practice subversive of the proper administration of justice, and violated petitioner's constitutional rights. Certiorari

should issue from this Court in the exercise of its supervisory jurisdiction.

Respectfully submitted,

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Washington, D. C.
July 10, 1964

APPENDIX A

IN THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF FLORIDA, MIAMI DIVISION

No. 9979-M-Civil-EC

Findings of Fact and Conclusions of Law

JOHNS-MANVILLE CORPORATION, A Corporation, *Plaintiff*,

v.

ITALIT, INC., A Corporation, *Defendant*.

FINDINGS OF FACT

1. This is an action for patent infringement, brought by plaintiff for infringement of claims 1 and 2 of United States Patent No. 2,738,992 which was duly and legally issued on March 20, 1956 to plaintiff as the assignee of Robert W. Heisler for an invention entitled "Pipe Coupling", against defendant based on its importation of pipe and couplings manufactured in Italy and sold by defendant in the United States in violation of the exclusive rights secured to plaintiff by the patent.

2. Plaintiff Johns-Manville Corporation is a corporation of the State of New York. Defendant, Italit, Inc., is a corporation of the State of New York having a regular and established place of business and a resident managing agent at Port Everglades Station, Fort Lauderdale, Florida, where it has committed acts of infringement by selling infringing asbestos-cement pipe and pipe couplings, imported from the Italian manufacturer, Eternit S.p.A., Genoa.

3. Plaintiff is a large producer of asbestos fibres and a manufacturer of products which include such fibres, among which are asbestos-cement pipes and couplings for such pipes. The asbestos-cement pipe art was originally developed many years ago in Italy by predecessors of defend-

ant's Italian supplier. In 1929 plaintiff became interested in the manufacture and sale in the United States of asbestos-cement pipe as an outlet for the asbestos fibres which it mined and manufactured (Tr. 33). Plaintiff pioneered in the commercial development of asbestos-cement pipe in the United States and is still a major producer in this country (Tr. 33).

4. Asbestos-cement pipe is made by forming a wet web of asbestos fibres, cement and silica on a machine not unlike a Fourdrinier machine used for manufacturing paper through depositing the web in concentric layers on a steel mandrel and subjecting the same to high pressure until a tube of desired thickness is built up, whereupon the tube is stripped from the mandrel and cured and dried in an autoclave at high temperature (Tr. 32). Pipe sections made in this manner have their ends plain and straight without enlarged or belled ends adapted to receive straight or "spigot" ends of other pipe sections, as is the case with cast or moulded pipes. Such asbestos-cement pipes cannot be connected together to form a pipe line by bell and spigot joints, nor by threading in combination with collars, but must be connected by joints making a fluid-tight connection with plain, straight, cylindrical ends of adjacent pipe sections.

5. Plaintiff acquired know-how, machines and patent licenses in 1929 from the Italian Eternit Company (Eternit S.p.A. of Genoa, Italy) which had pioneered in Europe in the development of asbestos-cement pipe and couplings. At that time the most popular pipe coupling in use in Italy and other European countries was known as the GIBAULT joint consisting of a cast iron flanged ring on each pipe end, a cast iron connecting sleeve, rubber gaskets between the rings and the ends of the sleeve, and large bolts connecting the rings to draw them together to compress the gaskets against the pipe and the cast iron sleeve (Tr. 37, 94, Pl. Ex. 114). Plaintiff did not employ the GIBAULT joint initially, but manufactured and sold a joint developed

by an official of Italian Eternit, known as the SIMPLEX coupling, shown in and covered by United States Patent No. 1,947,998, which has long since expired.

6. This SIMPLEX coupling included an asbestos-cement coupling sleeve encircling the adjacent ends of two pipe sections, with rubber rings disposed under great compression between the outer surfaces of the pipes and inner surface of the sleeve on opposite sides of the adjacent ends of each pair of pipes. Assembly of the SIMPLEX coupling was difficult. The rubber rings had to be placed on the pipes and the coupling sleeve had to be drawn by the application of high pulling forces from a position encircling one pipe, over the rubber rings to a position enclosing the abutting pipe ends. This was accomplished by a rolling action of the rings over the exterior of the pipe ends and along the inside of the sleeve. Jacks or pullers were required to exert the forces necessary to move the sleeve over the rings. The SIMPLEX joint as shown in the Mazza patent No. 1,947,998 was manufactured and sold by plaintiff in the United States from late 1929 until supplanted by the pipe coupling of the patent in suit, which was then sold under the trade mark RING-TITE.

7. Plaintiff was the only manufacturer of asbestos-cement pipe in the United States until 1936 when a wholly owned subsidiary of Turner-Newell Ltd. of England, named Keasbey & Mattison, commenced manufacturing asbestos-cement pipe in Ambler, Pennsylvania, with which it supplied the GIBAULT coupling. It continued to offer the GIBAULT coupling until 1947, when it acquired a license under the Mazza patent and commenced manufacturing the SIMPLEX coupling (Tr. 39). Keasbey & Mattison continued to offer the SIMPLEX joint until after the plaintiff introduced the RING-TITE coupling made in accordance with its patent in suit, when in 1955 it shifted over to the FLUID-TITE coupling referred to below.

8. By about 1949 customers using the SIMPLEX coupling (Tr. 39, 95) had made many complaints based pri-

marily on difficulties experienced in assemly of the coupling and on failures encountered in service after installation, due to rubber ring blow-out. In an effort to overcome the difficulties with the SIMPLEX coupling, plaintiff's employees then began a research program (Tr. 136), seeking improvement in coupling structures.

9. A preliminary design of plaintiff's employee, Robert W. Heisler in 1951 showed promise, and he was assigned to the project of making improvements thereon. His 1951 coupling could be assembled with less effort than the SIMPLEX coupling and had improved blow-out prevention characteristics. The SIMPLEX coupling was a "roll-on joint" with the rubber rings under very high compression, assembled under heavy pulling forces. The 1951 Heisler coupling was a lubricated joint with pressure assisted rings disposed in grooves in the coupling sleeve, which rings were adapted to slide along the lubricated surfaces of the pipe ends during assembly (Tr. 132, 133). The 1951 Heisler coupling was not satisfactory and was not adopted commercially because no positive means was provided for centering the sleeve over the pipe ends or for assuring that the ends of the pipes were separated from each other in assembled relation (Tr. 135, 136). It has always been necessary to space the adjacent ends of asbestos-cement pipe sections in a pipe line because the asbestos-cement material has the inherent characteristics of being expansible under increase in moisture content, such as is encountered when put into water main service. Space to permit expansion of individual sections must be provided to prevent the establishment of rigid, abutting engagement between pipe ends and to maintain flexibility of the line as a whole. With the SIMPLEX coupling, this spacing was provided after the couplings had been assembled, by manual manipulation of the pipe sections. (Tr. 92; Pl. Ex. 131, p.B.M.T. 508; and Tr. 252).

10. As a result of Heisler's continuing research efforts, on or about May 15, 1952, he completed the invention of

the patent in suit, as shown by entries in his laboratory notebook, Plaintiff's Exhibit 141. The new coupling was tested in the laboratory and demonstrated to representatives of American Water Works Service Company, leading to an initial installation by that company in February, 1953 at Long Branch, New Jersey, and an exhibition and demonstration to the industry at the American Water Works Association Convention in May, 1953 (Tr. 41-43; 141). Its commercial acceptance followed, and it supplanted the SIMPLEX coupling in plaintiff's production in less than three years (Tr. 44), during which plaintiff was offering both couplings.

11. The coupling made and sold by plaintiff in accordance with the patent in suit was a lubricated "push-in" coupling and was the first one of this type ever used in the asbestos-cement field. The patented coupling consists of an asbestos-cement sleeve having grooves in its inner surface in which rubber sealing rings are seated and arranged to be relatively lightly compressed as the lubricated pipe ends are pushed into the sleeve. The machined ends of the pipes are each provided with a circumferential *shoulder* at a predetermined distance from the end, to engage the rubber rings and to limit the movement of the pipe into the sleeve (Tr. 147, 148). The shoulder on the pipe *in combination* with the sealing ring in the groove in the sleeve is the heart of the invention, accomplishes new and useful results, makes possible an entirely new mode of operation, and the use of the shoulder in combination produces advantages which were not up to then foreseen.

12. The unforeseen advantages, unobvious functions and results of the RING-TITE coupling may be summarized as follows: First, the shoulder on the pipe disposed in abutting relation to the rubber sealing ring backs up the ring and cooperates with the groove in the sleeve to fix and set the ring so as to prevent any tendency of ring extrusion or ring blow-out under pressure surges (Tr. 150). Second, the shoulders center the coupling sleeve

with respect to the pipe ends and prevent the sleeve from being forced onto one pipe more than the other during assembly, by push-in action, of the first and subsequent pipe sections added to the line (Tr. 148, 149). Third, the shoulders on the pipe engage the rubber sealing rings in the groove and arrest the movement of the pipe into the coupling sleeve to provide end separation or spacing of the pipes (Tr. 148, 149). Fourth, the shoulder made possible a new and easier method of assembling the pipe in the ditch, by a procedure known as "belling ahead". In accordance with this procedure a coupling sleeve may be assembled on one end of each pipe section before the pipe is lowered into the ditch, or at the factory, to provide, in effect, a belled end, and the pipes are coupled in the ditch merely by jamming the spigot end of one section into the belled end of a previously laid section (Frazza, Tr. 98, 100; Trice Tr. 150-153).

13. Witnesses at the trial (Holmes and Walden) and deposition witnesses (Burdine, Parker and Weaver), all of whom were pipe line contractors having practical experience, testified to the advantages of the shoulders on the pipe in combination with the rubber sealing rings in the grooves in the coupling sleeve.

14. Defendant offered no evidence contradicting the evidence presented by plaintiff as to the advantageous results accomplished by the shoulder on the pipe ends in the combination of the patent in suit and does not disagree with plaintiff's position on this matter.

15. The Court saw and heard the witnesses who were employees of plaintiff and who had had long experience in the asbestos-cement pipe and coupling art and saw and heard the practical pipe line contractors, all of whom had had experience with plaintiff's patented coupling, including one witness called by defendant, and noted the agreement as to the importance of the shoulders on the pipe ends in combination with the known use of sealing rings in grooves.

Even defendant's contractor witness, Krane, testified that the shoulder tends to make the installation more foolproof.

16. The principal basis of defendant's attack on the validity of the patent in suit, made in argument in its brief, is a contention that it would have been obvious to a person having ordinary skill in the pipe coupling art to provide on the pipe of the Turner Patent No. 2,294,142, a shoulder as taught by the Houze patent No. 543,871. There is no testimony by defendant's expert or any other witness that the addition of shoulders to the pipe in the Turner patent would be obvious and no witness for defendant was interrogated upon the point. Plaintiff's witness, Trice, gave detailed reasons (Tr. 439-443) why in his opinion the addition of such shoulders to the ends of asbestos-cement pipe would not be and were not obvious.

17. Although defendant relied upon 24 prior patents for anticipation of the patent in suit or in an effort to show lack of invention, there was no evidence that any of the constructions shown in the patents represented a practical pipe coupling which had been put into actual commercial use, or had ever been used or sold.

18. Four prior patents were relied upon by defendant's expert as showing the use of shoulders on pipes adapted to engage and compress rubber sealing rings in coupling sleeves or bells, but none of these patents showed a sealing ring in a groove in a sleeve adapted to be lightly compressed by the pipe ends to provide a pressure assisted seal. Similarly, defendant relied upon three patents showing sealing rings disposed in grooves in coupling sleeves or bells, but these patents did not have shoulders on the pipe ends adapted to abut the rings to provide an improved seal, prevent ring blow-out, effect sleeve centering, and provide automatic end separation.

19. The patents relied upon by defendant, showing shoulders on pipe end, Houze 543,871, August 6, 1895:

Miller 2,177,438, October 24, 1939; Osborn 2,590,565, March 25, 1952; Beyer 2,693,378, November 2, 1954; and Italian Patent 458,520, July 20, 1950, are no more pertinent than patents cited by the Patent Office and considered by the Examiners showing shoulders on the pipe, namely, Nathan 2,209,235, July 23, 1940; Hirsh 2,470,818, May 24, 1949; British Patent 458,958, December 30, 1936; and Halkyard 2,272,115, February 3, 1942. Defendant relied on another group of patents as showing the use of sealing rings in grooves disposed in coupling sleeves or bells, namely, Turner 2,294,142, and A.P.C. Publication S.N. 293,149, Boissou, published May 25, 1943, and 2,180,795, Christensen, November 21, 1939. These patents are no more pertinent than patents cited by the Patent Office showing rubber rings disposed in grooves, such as Kenyon 865,498, September 10, 1907; Beyer et al. 2,184,376, December 26, 1939; Nathan 2,209,235, July 23, 1940 (Figs. 1-3); Parker 2,478,127, August 2, 1949; Jones 2,639,169, May 19, 1953; and Baines British Patent 415,425, August 24, 1934.

20. Although there is no single new element in the plaintiff's patent that constitutes a patentable invention in and of itself, the combination of old elements, or previously known elements, or elements of prior art, particularly as respects the shoulder on the pipe, has produced a new and useful and patentable improvement over all previously known couplings. The elements of claims 1 and 2 of the patent in suit constitute a true patentable combination, and not a mere aggregation of old elements. All of the elements cooperate with each other to perform new and useful results in an improved manner and were combined through the exercise of invention. The new combination of old elements brought together for the first time by the inventor, Heisler, would not have been and was not obvious to one having ordinary skill in the art at the time the invention was made.

21. Keasbey & Mattison was the owner of the United States patent to Turner, No. 2,294,142, dated August 25, 1942, which is now the principal item of prior art relied upon by defendant in its attacking the patent in suit. Although the patent was granted more than ten years prior to the advent of the Heisler RING-TITE coupling, it was never used commercially by Keasbey & Mattison to avoid the difficulties and drawbacks of the SIMPLEX coupling, either before or after the introduction of plaintiff's patented RING-TITE coupling. Although the Turner patent shows all of the elements of the Heisler invention except the shoulders on the pipe ends, the construction was impractical and has never gone into commercial use (Trice, Tr 442; Bradt, Tr. 381, 382). The absence of the shoulders on the pipe ends made the Turner construction impractical, just as was the 1951 Heisler coupling, which had no shoulders. The Court finds that it was not and would not have been obvious to Turner or Keasbey & Mattison to provide shoulders on the pipe ends to perform the functions accomplished by the shoulders in the combination of the Heisler patent.

22. Plaintiff's patented RING-TITE joint was the first departure in the commercial asbestos-cement pipe and coupling field from the old SIMPLEX coupling. Since the introduction of the patented RING-TITE coupling by plaintiff, all sales of SIMPLEX couplings have been discontinued in the United States and all competitive asbestos-cement pipe and couplings offered in this country have included lubricated push-in type joints with some provision for effecting end separation and sleeve centering.

23. In 1955, Keasbey & Mattison introduced a coupling known as FLUID-TITE in accordance with its Altemus patent 2,871,031 (Pl. Ex. 137; Frazza, Tr. 107-109). With this joint, it was necessary to use removable clips or spacer forks placed over each pipe end in engagement between a shoulder on the pipe and the end of the coupling

sleeve to limit the movement of the pipe into the sleeve. The clips were removed after several lengths of pipe had been laid.

24. The Belgian Eternit Company sold asbestos-cement pipe in this country commencing in about 1958 (Frazza, Tr. 110; Pl. Ex. 138) in which two additional rubber rings were employed beyond the ends of the coupling sleeve abutting an external shoulder on the pipes to act as stop rings and provide sleeve centering and end separation. Mr. Gerin of Eternit Belgium characterized the use of the supplementary rings of the Belgian joint and the clips or forks of the Keasbey & Mattison as being "less elegant" than the solution to the problem previously provided by plaintiff, namely, the stop shoulder on the pipe ends engaging the rubber sealing rings in the grooves in the sleeve.

25. Eternit A.G. of West Germany exported asbestos-cement pipe and couplings to this country in 1958 (Frazza, Tr. 113; Pl. Ex. 139) which included the REKA coupling, also employing external spacing clips.

26. The unexpected advantage and results of plaintiff's RING-TITE coupling were of such commercial importance that plaintiff's principal competitors were compelled to adopt and offer some expedient which would provide sleeve centering and end separation in their couplings, and all, except defendant, went to external clips, clamps, or additional rubber rings presumably out of respect for the RING-TITE patent in suit.

27. Defendant was organized in 1955 by Charles A. Koons to take over the importation and distribution in the United States of asbestos-cement pipe and couplings manufactured by Eternit S.p.A. in Genoa, Italy. When it entered the field, defendant offered only the SIMPLEX coupling. As early as 1957, it determined that, in order to compete with the plaintiff's RING-TITE coupling and

the Keasbey & Mattison FLUID-TITE coupling, the SIMPLEX coupling would have to be replaced. Defendant's managing agent in Florida complained to defendant's Vice President, Litynski (Pl. Ex. 19) that most people figured that it cost about 10c per foot extra when using SIMPLEX couplings as compared to RING-TITE or FLUID-TITE couplings.

28. In 1957, defendant's Italian supplier submitted literature and samples of a lubricated push-in type coupling known as SUPER-SIMPLEX as a substitute for the old SIMPLEX coupling (Pl. Ex. 3 and 4). The sales manager, Angie, of defendant's West Coast distributor wrote to defendant (Pl. Ex. 18) that the SUPER-SIMPLEX was well liked and that he thought it would be accepted alongside of the Johns-Manville and Keasbey & Mattison joints. This coupling was sold by defendant from the latter part of 1957 through a part of 1959. Its construction is shown in a brochure, Plaintiff's Exhibit 4, stipulated to be an accurate representation of the coupling. The SUPER-SIMPLEX seal did not have a shoulder on the pipe ends nor any external clamps or rings to effect end separation and sleeve centering. Instead, these results were supposed to be accomplished by the manual manipulation by the operator attempting to register the ends of the sleeve with scribe marks on the pipes. No charge of infringement was directed by plaintiff against the SUPER-SIMPLEX.

29. The testimony of all of the pipe line contractors who appeared at the trial and whose depositions were taken establishes that the absence of the shoulders on the pipe ends and the inability to provide sleeve centering and end separation made the SUPER-SIMPLEX coupling unsatisfactory. Many of the contractors stated that they would not buy any more of the SUPER-SIMPLEX couplings and most of them stated that they had so advised Vinmont, defendant's managing agent in Florida.

30. The evidence establishes the unsatisfactory character of the SUPER-SIMPLEX coupling, and the difficulties, problems and troubles encountered in its use, as well as the efforts made by defendant's officers and its West Coast distributor to have the Italian manufacturer furnish an improved coupling which would avoid the difficulties of the SUPER-SIMPLEX and would provide the automatic features of plaintiff's coupling. Samples of the accused coupling, known as the SS AUTOMATIC SEAL, were received late in December, 1958. The correspondence between Angie, sales manager of the West Coast distributor and defendant, and, between defendant's officers, Litynski and Winter, and the Italian supplier, in evidence (Pl. Ex. 27, 29, 31, 32, 38, 39-56 and 89) demonstrates frantic efforts to have the Italian manufacturer supply exclusively the new S.S. AUTOMATIC SEAL and to secure Underwriters' approval thereof. Shipments started on a large scale in June or July, 1959, and substantially all asbestos-cement pipe imported by defendant since then has been of the accused construction.

31. Defendant urged its supplier, Eternit S.p.A., Genoa to duplicate the automatic features of Johns-Manville's RING-TITE coupling and notified its customers, when the S.S. AUTOMATIC SEAL was available, that the new pipe and couplings avoided the difficulties previously encountered with SUPER-SIMPLEX and were equal to RING-TITE (Pl. Ex. 57-69).

32. The Defendant's accused coupling, identified as the "SS AUTOMATIC SEAL", is stipulated to be substantially correctly illustrated in a brochure in evidence as Plaintiff's Exhibit 2 (Pretrial Stipulation). The similarity between defendant's S.S. AUTOMATIC SEAL and plaintiff's patented coupling is apparent from a comparison of this brochure with Figure 4 of the patent in suit, and particularly by a comparison of the enlarged drawings in evidence as Plaintiff's Exhibits 129 and 142. The only

structural distinctions which can be found are in the specific cross-sectional shapes of the grooves in the coupling sleeves and the rubber rings seated therein, but these differences are of no importance, as claims 1 and 2 of the patent are not limited to such details.

33. Claims 1 and 2 of the patent in suit may be applied literally to the defendant's accused structure, as demonstrated by plaintiff's witness, Trice (Tr. 155-164) and by Plaintiff's Exhibit 145, a reproduction of Plaintiff's Exhibit 2 having numerals and legends applied thereto corresponding to the numerals on the patent drawings and the claim limitations.

34. There is nothing in the file wrapper of the patent in suit requiring a more limited interpretation of claims 1 and 2 of the patent than is apparent from their plain terms. There is nothing showing an intention by the Solicitor or the Examiner to limit claims 1 and 2 to a particular shape of sealing ring or groove, as claim 3 of the patent is limited.

35. In this case, the defendant's S. S. AUTOMATIC SEAL literally infringes claims 1 and 2 of the patent. Resort to the doctrine of equivalents is, therefore, unnecessary. As stated by the Supreme Court in *Graver Tank Co.* v. *Linde Air Products Co.*, 339 U.S. 605, 607, "If accused matter falls clearly within the claim, infringement is made out and that is the end of it."

36. In any event, defendant's device is an equivalent of the patented device, as it performs substantially the same functions, in substantially the same way, to obtain the same results. A comparison of the objects and functions of the invention of the patent in suit (Tr. 145, 146; Pl. Ex. 1, col. 2, ls. 18-42) with the written matter describing defendant's SS AUTOMATIC SEAL in Plaintiff's Exhibit 2 establishes that the same objects and functions are performed in both, by the same means, with the same

results. Defendant's brochure (Pl. Ex. 2) emphasizes all of the advantages first provided by plaintiff's patented construction. Defendant's witnesses did not dispute this conclusion and did not contend that the advantages of the RING-TITE construction were not present in the SS AUTOMATIC SEAL.

37. Defendant's contentions with respect to non-infringement are untenable. Its expert referred to only a few points upon which he disagreed with plaintiff's application of the claims to defendant's structure. Defendant denied that its resilient readily deformable gasket in the groove in its sleeve had greater initial radial thickness than the distance between the outer wall of the groove and the radially outer portion of the pipe end, and denied that the gasket was engaged between these surfaces "under relatively light radial compressive force in assembled relation and is at least slightly flattened in a radial direction." The testimony of defendant's witness on these points was inconsistent and unconvincing. After weighing the evidence, the Court finds that these two limitations are satisfied by defendant's structure.

38. Defendant also contends that the annular groove, which is admittedly formed generally radially outwardly from the inner circumference of the sleeve, does not have "a radially outer wall" and "generally radially extending axial end walls." Defendant admits that the groove has one such end wall, but denies the presence of two. The testimony of defendant's expert witness was not convincing, and the Court finds that the upper portion of the sloping surface indicated at 10 in Exhibit 145 is "a radially outer wall", and that the lower or end portion indicated at 16 is a "generally radially extending" end wall within the meaning of the claim, and that these surfaces function in the same way as the groove walls 10 and 16 in the Heisler patent.

39. Defendant refers to a claim limitation with respect to the groove being of greater width between its end walls than the thickness of the gasket in that direction to provide space for limited axial deformation of the gasket in opposite directions under fluid pressure in opposite directions. The Court finds that such a space is provided on both sides of defendant's gasket between the gasket material and the end walls and that these spaces are clearly shown in Plaintiff's Exhibit 145. The testimony of defendant's expert Bradt to the contrary is not convincing. He admitted on cross-examination that a space was provided in which the gasket, under extreme pressure, could deform (Tr. 399).

40. The final contention of defendant is that, since its groove does not have an outer end wall, the shoulder on the pipe does not lie at least in part radially opposite the outer end wall. Since the premise is false, the conclusion falls. As shown in Plaintiff's Exhibit 145, the shoulder 32 on the pipe is radially opposite the portion 16 of the sloping surface, which the Court finds is an end wall of the groove.

41. The forked sealing ring of the Turner patent 2,294,142, the circular section ring of the Heisler patent, and the generally triangular, V-shaped ring of the defendant's SS AUTOMATIC SEAL are all squeeze type, pressure assisted, interference seals, and all behave in a similar manner when fluid pressure is applied to a seal joint (Pl. Ex. 149, p. 91; Pl. Ex. 150, pp. 68, 69).

42. Defendant's sealing ring is not a true "V ring" as that term is used in the dynamic seal art because the outer surfaces of the lips and the solid portion of the heel are in surface contact with the surfaces to be sealed, the rings are installed singly, and at least the heel or solid portion of the ring is compressed.

43. Claim 3 of the patent in suit, which is not charged to be infringed, is limited to the specific cross-sectional

shape of the groove in the sleeve, as shown in the patent, and to a readily deformable gasket having a substantially circular cross-sectional shape in relaxed condition. Claims 1 and 2 are not so limited. Defendant attempts to read these limitations into claims 1 and 2. These broader claims will not be construed to contain limitations expressed in the more narrow claims. *Cameron Iron Works* v. *Stekoll*, CA 5, 1957, 242 F.2d 17, 21; *Bryan* v. *Richardson*, CA 5, 1958, 254 F.2d 191, 196; *Hemphill Company* v. *Holeproof Hosiery Company*, D.C. N.D. Ga. 1956, 143 F. Supp. 727, 731.

44. Defendant has failed to present evidence which would sustain a finding of non-infringement of claims 1 and 2 of the patent in suit or of non-equivalency between defendant's coupling and plaintiff's patented coupling.

45. Since March 20, 1956, the date of the grant of the Heisler patent in suit, plaintiff has applied to the pipe couplings made under the patent, the number of the patent, namely Pat. 2,738,992. Plaintiff has complied with the requirements of 35 U.S.C. Section 287, and has given notice to the public as specified therein.

46. Although defendant's president, in answer to interrogatories (Pl. Ex. 17, Int. 13) and in his testimony at the trial (Tr. 297) claimed he did not have knowledge of plaintiff's patent when the accused SS AUTOMATIC SEAL was sold in the United States, defendant was completely informed as to plaintiff's coupling and its construction and functional advantages. Defendant's counsel admitted (Tr. 70) that defendant's knowledge was more a knowledge of the coupling than of the patent on the coupling, but no explanation was given by defendant's president or other witnesses as to their failure to inform themselves about the plaintiff's patent. Although there is a disagreement between the testimony of plaintiff's Vice President, Orth, and defendant's President, Koons, as to the date when defendant was first given notice of the

charge of infringement, the Court finds that defendant either had actual notice of the patent or could readily have secured complete information with respect thereto when it first introduced the accused construction in 1959.

47. The correspondence in evidence between defendant and its Italian supplier and between defendant's managing agent in Florida and his customers establishes that defendant appreciated the novel and important features of plaintiff's RING-TITE coupling which made it commercially advantageous, and that defendant deliberately prevailed upon its supplier to include the same features in its coupling to meet the competition, and so advised its customers when it had done so (Pl. Ex. 38, 57-69).

Conclusions of Law

1. This Court has jurisdiction over the parties and the subject matter of this action.

2. Plaintiff is the owner of the entire right, title, and interest in and to the Heisler patent in suit, No. 2,738,992, and has been such owner continuously since the date of the grant, March 20, 1956.

3. The patent is presumed to be valid and the burden of establishing invalidity rests upon defendant (35 U.S.C. 282), and any reasonable doubt will be resolved against him (35 U.S.C. 282, *Cameron Iron Works* v. *Stekoll*, CA 5, 1957, 242 F.2d 17, 20, *Adams* v. *Columbus Manufacturing Co.*, D.C. N.D. Ga. 1960, 180 F. Supp. 921, 930).

4. The statutory presumption of validity is not overcome where the most pertinent patents relied upon by defendant to show lack of invention are no more pertinent than those considered by the Patent Office during the prosecution of the application on which the patent in suit issued. (*Otto* v. *Koppers*, CA 4, 1957, 246 F.2d 789, 800, 801; *Southern States Equipment Corporation* v. *USCO Power Equipment Corp.*, CA 5 1953, 209 F.2d, 111, 118).

5. The commercial success of the coupling made and sold by plaintiff under the Heisler patent in suit, its acceptance by the trade, and its effect in supplanting prior couplings, further strengthen the statutory presumption of validity of the patent.

6. The defendant has not sustained the burden of proof necessary to overturn the presumption of validity attaching to the patent from its grant or the administrative determination of patentability made by the Patent Office in granting the patent.

7. The combination of the Heisler patent is a true and patentable combination.

8. A new combination of old elements producing new, useful, and unexpected results is patentable under the Patent Laws of the United States.

9. A new combination of old or previously known elements which are brought together for the first time in a manner which would not be obvious to a person having ordinary skill in the art and which cooperate to produce a new and useful improvement over all previously known combinations, is patentable.

10. The invention of the Heisler patent in suit is patentable since it is not anticipated by the prior art and the subject matter as a whole would not have been obvious to a person having ordinary skill in the art at the time the invention was made.

11. The citation of a large number of prior art patents by defendant emphasizes the long search for the patented construction and demonstrates the unobviousness of the invention to one having ordinary skill in the art.

12. The patent in suit, No. 2,738,992, as to claims 1 and 2, the only claims in suit, is good and valid in law.

13. A broad claim in a patent will not be construed to contain limitations expressed in more narrow claims, since each claim is in theory a separate patent and no two claims should be so construed as to make them identical (*Cameron Iron Works* v. *Stekoll*, CA 5, 1957, 242 F.2d 17, 21).

14. Claims 1 and 2 of the patent in suit have been infringed by the defendant by its sale of asbestos-cement pipe and couplings designated SS AUTOMATIC SEAL.

15. Plaintiff is entitled to an injunction restraining defendant from infringement of claims 1 and 2 of the Heisler patent.

16. In accordance with the provisions of Title 35 United States Code, Section 284, plaintiff is entitled to an award of damages adequate to compensate for the infringement, in no event less than a reasonable royalty for the use made of the invention by the defendant, together with interest and costs as fixed by the Court. The cause will be referred to a Master to take an account and to report to the Court the damages sustained by plaintiff, and the Court will assess them.

17. Plaintiff shall recover its taxable costs as fixed by the Court, with interest upon the amount of damages from the charge of infringement (35 U.S.C. 284).

EMETT C. CHOATE
U. S. District Judge

Dated at Miami, Florida
This 9th day of April, 1962.

IN THE UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

No. 9979-M-Civil-EC

JOHNS-MANVILLE CORPORATION, A Corporation, *Plaintiff*,

v.

ITALIT, INC., A Corporation, *Defendant*.

Interlocutory Judgment

This cause having come on for consideration upon the pleadings, the pre-trial stipulation of the parties, the evidence presented at the trial, and the briefs of the parties, the Court being advised in the premises, and having filed its findings of fact and conclusions of law herein, it is hereby,

ORDERED, ADJUDGED, AND DECREED THAT:

1. The complaint for patent infringement is sustained.

2. Claims 1 and 2 of the Heisler patent in suit No. 2,738,992 are valid.

3. Claims 1 and 2 of the Heisler patent in suit No. 2,738,992 have been infringed by the defendant by its sale of asbestos-cement pipe and couplings designated SS AUTOMATIC SEAL.

4. Plaintiff is entitled to an injunction restraining the defendant from infringement of claims 1 and 2 of the Heisler patent in suit, No. 2,738,992.

5. This cause will be referred to Leland Hyzer, Esquire, as a Master to take an account and to report to the Court the damages sustained by plaintiff under the provisions of Title 35 United States Code, Section 284, and in order to

enable the Court to assess the damages, the Master is instructed to report the value of sales of all asbestos-cement pipe couplings sold in the United States by defendant of the type known as SS AUTOMATIC SEAL, as well as the number of lineal feet of each size and type of such pipe sold, and make findings as to what would constitute a reasonable royalty to plaintiff for the use of the infringing joints had they been licensed, and offer such findings as his recommendations.

6. Plaintiff is entitled to its costs and disbursements to be taxed and included and made a part of the final judgment in this cause.

EMETT C. CHOATE
U. S District Judge

Dated: April 9th, 1962
at Miami, Florida

APPENDIX B

IN THE

United States Court of Appeals

FOR THE FIFTH CIRCUIT

No. 19684

ITALIT, INC., *Appellant*,

VERSUS

JOHNS-MANVILLE CORPORATION, *Appellee*.

(April 16, 1964.)

Appeal from the United States District Court for the Southern District of Florida.

Before RIVES and CAMERON,[1] Circuit Judges, and HUNTER, JR., District Judge.

RIVES, Circuit Judge: This appeal is from an interlocutory judgment finding Claims 1 and 2 of Patent

[1] Circuit Judge Ben F. Cameron participated in the hearing of the case, but not in its decision. His death occurred on April 3, 1964.

No. 2,738,992[2] valid and infringed. The district court

[2]1. A pipe coupling for confining a fluid therein comprising, an inner pipe section having an end portion of generally cylindrical outer circumference but comprising two annular portions of different *substantially constant* outside diameters joined by a shoulder extending generally radially outwardly at a relatively steep angle to the axis of said inner pipe section, an outer pipe section having a generally cylindrical inner circumference defining an opening receiving said end portion of said inner pipe section, the annular portion of said inner pipe section end having the smaller outside diameter being located the closer axially to the axially inner extremity of the inner pipe section, the maximum outside diameter of said end portion being somewhat smaller than the diameter of said opening to provide clearance for axial movement and limited canting of the pipe sections relative each other, said outer pipe section having the annular groove formed generally radially outwardly from its inner circumstance and having a radially outer wall radially opposite at least a part of said annular portion of smaller outside diameter, and a resilient readily deformable gasket in said groove having a greater initial radial thickness than the distance between said radially outer wall of the groove and said radially opposite portion of the outer circumference of said inner pipe section end portion and being engaged therebetween under relatively light radial compressive force in assembled relation and at least slightly flattened in a radial direction, said groove having *generally radially extending* axial end walls and a somewhat greater width axially of the outer pipe section and between said end walls than the thickness of the gasket in that direction in its initially flattened state to provide space for limited axial deformation of the gasket material toward and against either one of the axial end walls of the groove and away from the respective other end wall in response to a fluid pressure differential resulting in a greater effective fluid pressure on that side of the gasket lying toward said respective other end wall of the groove, said shoulder being spaced a desired, predetermined distance from said inner extremity of the inner pipe section, said predetermined distance being such that said shoulder positively orients said inner pipe section in a desired predetermined position axially with respect to said outer pipe section when said pipe sections and gasket are brought together in the aforesaid relationship in assembly of the coupling with said shoulder and the one end wall of said groove axially opposite said shoulder both in contact with said gasket, *said shoulder lying at least in part radially opposite the other one of said end walls of the groove in said assembled relationship.*" (Emphasis added for reason expressed in text to footnote 8, *infra*.)

[2]2. A pipe coupling as defined in claim 1, in which said outer pipe section is in the form of a sleeve, and comprising

entered findings of fact and conclusions of law[3] which, except for some minor changes, had been prepared by counsel for Johns-Manville.[4]

The patent is for a push-in pipe coupling for use principally with asbestos-cement pipe similar to the coupling for use with cast iron pipe held valid in *U.S. Pipe & Foundry Co.* v. *James B. Clow & Sons, Inc.*, N.D. Ala. 1962, 205 F. Supp. 140. That decision was reversed for determination of the issue as to who was the first inventor, with the following ruling as to patentability:

> "The contention that the patent is devoid of any inventive contribution in view of the prior art, and that it was not infringed are both without merit, as is the argument that the claims failed to meet the statutory requirement of

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further a second inner pipe section having an end portion formed similarly to the first-mentioned inner pipe section end portion and similarly received in, and related to, the opposite end of said sleeve, and a second gasket similarly received therebetween, at least said inner pipe sections comprising hardened, compressed, fibro-cement material, said inner pipe section end portions and said sleeve being disposed in generally coaxial relationship, the spacing of the annular wall portions on the inner pipe sections from their respective axially inner extremities being such that said extremities are spaced at a desired predetermined distance axially from each other with the gaskets and associated wall portions at the opposite ends of the sleeve and on the inner pipe section end portions respectively in contact as aforesaid, and also with the shoulder on each inner pipe section lying at least in part radially opposite the respective said other one of said end walls of the associated groove."

3 Reported as Johns Manville Corporation v. Baltz, Inc., S.D. Fla. 1962, 209 F.Supp. 798.

4 For the significance to be attached to that circumstance, see Kinyon Wood Corporation v. Humble Oil & Refining Co., 5 Cir. 1958, 259 F.2d 398, 401, and the full discussion in Louis Dreyfus & Cie. v. Panama Canal Co., 5 Cir. 1962, 298 F.2d 733, 737-739.

definiteness. Also, the claim of file wrapper estoppel was not made out. These matters were carefully considered by the District Court and the findings and conclusions in regard to them find adequate support in the record. To this extent, and except as stated, the judgment is affirmed."

The district court in the present case described what it referred to as "the heart of the invention" in its finding numbered 11 (209 F. Supp. 800, 801):

> "The coupling made and sold by plaintiff in accordance with the patent in suit was a lubricated 'push-in' coupling and was the first one of this type ever used in the asbestos-cement field. The patented coupling consists of an asbestos-cement sleeve having grooves in its inner surface in which rubber sealing rings are seated and arranged to be relatively lightly compressed as the lubricated pipe ends are pushed into the sleeve. The machined ends of the pipes are each provided with a circumferential *shoulder* at a predetermined distance from the end, to engage the rubber rings and to limit the movement of the pipe into the sleeve (Tr. 147, 148). The shoulder on the pipe *in combination* with the sealing ring in the groove in the sleeve is the heart of the invention, accomplishes new and useful results, makes possible an entirely new mode of opera-

tion, and the use of the shoulder in combination produces advantages which were not up to then foreseen."

The issuance of the patent carries with it a presumption of validity.[5] Italit's attack on the validity of Claims 1 and 2 (n. 1, *supra*) is based upon obviousness or lack of invention.[6] On the issue of validity the district court made extensive findings of fact culminating in finding No. 20:

> "20. Although there is no single new element in the plaintiff's patent that constitutes a patentable invention in and of itself, the combination of old elements, or previously known elements, or elements of prior art, particularly as respects the shoulder on the pipe, has produced a new and useful and patentable improvement over all previously known couplings. The elements of claims 1 and 2 of the patent in suit constitute a true patentable combination, and not a mere aggregation of old elements. All of the elements cooperate with each other to perform new and useful results in an improved manner and were combined through the exercise of invention. The new combination of old elements brought together for the first time by the inventor, Heisler, would not have been and was not obvious to one having ordinary skill in the art at the time the invention was made." (209 F. Supp. 802.)

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[5] 35 U.S.C.A. § 282.

[6] See 35 U.S.C.A. § 103.

This finding of fact cannot be set aside as clearly erroneous, and it warrants the conclusion that the statutory requirements for patentability have been met.[7]

Claims 1 and 2 are charged to be infringed. One of these claims applies more particularly to a sleeve type while the other applies to a bell and spigot type coupling.[8] Claim 2 is dependent upon Claim 1 and cannot be infringed if Claim 1 is not infringed. The district court was unquestionably correct in that part of its finding No. 20, heretofore quoted, to the effect that each of the elements recited in Claims 1 and 2 were old in the art.

The application for the patent as originally filed contained fourteen claims, all of which were rejected by the examiner upon various grounds, his communication concluding:

> "Claims 1 through 14 are further rejected on the ground of undue multiplicity. In view of the relative simplicity of applicant's device and the advanced state of the art as illustrated by the cited references supra, it is believed that applicant's invention if any, may be adequately claimed in not more than two claims."

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7 *See* Graver Mfg. Co. v. Linde Co., 1949, 336 U.S. 271, 274, 275.

8 The patent contains three claims. Claim 3 specifically recites a gasket "having a substantially circular cross-sectional shape in relaxed condition" and is not in this suit.

In an amendment the applicant cancelled ten of the fourteen pending claims and added six new claims, stating that:

> "The reference cited and the grounds of rejection applied against the claims originally in this application have been very carefully studied, and the claim structure has been altered by the instant amendment in a manner considered to distinguish patentably from the art and to overcome the several grounds of rejection, including the rejection on the ground of undue multiplicity, for the reasons pointed out below."

Again all of the claims were rejected with the statement that, "This rejection is final." In response, the applicant cancelled all of the claims and added five new claims, three of which, after amendment, became the claims finally allowed. The applicant stated that the new claims "are considerably more specific," and further,

> "The claims also provide for clearance for deflection of the pipe sections within the coupling sleeve, and the gaskets involved are specified to be of the readily deformable type, such as used in 'O-ring' constructions, the gaskets being stated to be held under relatively light radially compressive forces so as to provide for easy assembly of the coupling."

The examiner responded that the most detailed claim, which was eventually allowed as Claim No. 3, not here in suit, "appears to be allowable," but rejected the other four claims. After appeal to the Board of Appeals, the applicant cancelled two of the claims and further amended the other two which were eventually allowed as Claims 1 and 2, stating:

> "While claims 23 and 24 are still considered allowable over the references in their unamended form, the instant amendment to these claims is proposed as more clearly delineating the novelty in the combination from the teaching of the references, as discussed hereinafter in detail."

The language added to Claim 23, which became Claim 1 as finally allowed, is that which we have emphasized in n. 1, *supra*. The detailed discussion by applicant's attorney reads in part as follows:

> "The proposed amendment to line 4 of claim 23 specifies the substantially constant nature of the two different outside diameters of the annular portions joined by the shoulder on the inner pipe section. The proposed amendment to line 26 of claim 23 *leaves no room for any possible doubt as to the direction in which the axial end walls of the groove extend*. The amendments to lines 41 and 43 of claim 23 are considered especially significant in locating the shoulder at least in part radially opposite

the same end wall of the groove in the assembled relationship as brought out in allowed claim 25, the difference being that the exact shape of that end wall is not specified in claim 23. This relative location of the said end wall and the shoulder is believed to be a critical feature of the combination, since the particular end wall involved must be so located in order to cooperate with the shoulder in preventing gasket blow-out under positive line-pressure off-conditions. Claim 24, as dependent from claim 23, contains all the novel features thereof, together with the additional novel features recited therein, and should clearly be allowable with claim 23." (Emphasis added.)

While Claim 3 of the patent specifically calls for the gasket to be "circular," Claims 1 and 2 do not contain this express limitation. However, the gaskets defined in Claims 1 and 2, because of the prosecution of the application and because of the relationship set out in the claims of the axial width of the groove with respect to that of the gasket, can only be limited to "O-ring" type gaskets. This does not mean that the gaskets must be circular or must have an "O" shape, but only that they be gaskets which seal under the "O-ring" principle of sealing. "O-ring" type gaskets may take many different shapes provided that the gasket is readily deformable. For example, an "O-ring" type gasket may be square shaped, delta shaped or X shaped.

"V-ring" seals, which were distinguished over during the prosecution of the application, seal on an entirely different principle than an "O-ring" gasket. They do not depend upon being deformed or squeezed into a space between pipe sections in order to make a seal, but rather depend upon fluid pressure to force the lips of the "V" apart against the parts to be sealed so that the greater the hydraulic pressure, the greater will be the force against the lips pushing them against the parts to be sealed.

In *Keystone Co.* v. *Northwest Engineering Corporation*, 1935, 294 U.S. 42, 48, the Supreme Court said:

> "We do not attribute the force of an estoppel to what was said by the claimant in seeking to avoid the prior art cited against his broad claims, but we do apply the principle that where such broad claims are denied and a narrower substituted, the patentee is estopped to read the granted claim as the equivalent of those which were rejected."

See also, *Southern States Equipment Corporation* v. *USCO Power Equipment Corporation*, 5 Cir. 1953, 209 F. 2d 111, 121.

Claims 1 and 2 cannot be given a construction broad enough to encompass Italit's S-S automatic coupling, which utilizes a "V-ring" gasket, that does not move axially in its V-shaped groove to effect any seal.

Italit's coupling does not have the elements specifically defined in Claims 1 and 2. It does not have a groove in the outer pipe section which has "axial end walls" and "a radially outer wall radially opposite at least a part of said annular portion of smaller outside diameter" of the inner pipe section as required in Claim. Instead of the three walls called for, it has two walls, one being a slanted wall (at an acute angle—not radially extending) and the other being a radially extending end wall which join to form a triangular shaped groove. Italit's groove is the type of groove adopted to fit the "V-ring" lip-seal type of gasket Italit uses.

Italit's coupling does not have the *two* "generally radially extending axial end walls" called for in the claims. It does have one such wall. It would be straining things to say that its slanted wall was a "generally radially extending wall portion."

Italit's coupling groove does not have "a somewhat greater width axially of the outer pipe section and between said end walls than the thickness of the gasket in that direction in its initially flattened state to provide space for limited axial deformation of the gasket material towards and against *either one* of the axial end *walls* of the groove and away from the respective *other* end wall . . ." (Emphasis added.) as called for in the claims. The axial width of the groove in Italit's coupling is the same axial width as is the "V-ring" lip-seal gasket which fits into the groove.

Italit's coupling does not have "said shoulder lying at least in part radially opposite the other one of said end walls of the groove in said assembled relationship." The shoulder lies radially opposite a slanted wall of the groove and not any end wall which is "generally radially extending" as the end walls are defined in the claims. The only "radially extending" end wall is not "radially opposite" the shoulder on the pipe end.

Italits coupling does not have a gasket which is engaged between the radially outer wall of the groove and the outer circumfergnce of the inner pipe section, so that it is "slightly flattened in a radial direction" and so arranged in the groove that there may be "limited axial deformation of the gasket material toward and against either one of the [generally radially extending] axial end walls . . . ." The gasket utilized in Italit's seal is a "V-ring" lip-seal gasket operating on a principle different from the "O-ring" squeeze principle of sealing and does not require any axial deformation to make a seal.

The district court erred in finding that Claims 1 and 2 of the patent in suit have been infringed by the defendant, Italit. The judgment is therefore reversed and the cause remanded for further proceedings consistent with this opinion.

REVERSED AND REMANDED.

APPENDIX C

Comments on Incorrect Fact Statements of Court of Appeals

The last seven paragraphs of the court of appeals opinion (Exhibit B, pages 10-12) contain statements that respondent's gasket and groove do not have certain physical properties defined by quoted portions of the claims in suit. All of the limitations so quoted or paraphrased by the court of appeals were contained in original claims 2 and 3 of the application from which the patent in suit matured. Original claim 2 reads in part as follows (R. 685, 686):

> "... a resilient readily deformable gasket ... engaged by the radially outer wall of the groove and the radially opposite portion of the outer circumference of said pipe section end *under relatively light radial compressive force and at least slightly flattened radially*, said *groove having axial end walls* and a *sufficiently greater width axially of the outer pipe section and between said end walls than the thickness of the gasket in that direction in its initially flattened state* to provide space for limited axial deformation of the gasket material *toward and against either one of the axial end walls* of the groove and away from the respective other end wall in response to the fluid pressure differential ...."

Original claim 3 (R. 686,687) required that the outer end wall of the groove extend "radially outwardly".

The Patent Office held (R. 695) that the language quoted above could be literally read upon the gasket and groove of Kenyon U.S. Patent No. 865,498 (R. 760), and upon Nathan U.S. Patent No. 2,202,235 (R. 777), each of which shows a gasket and groove substantially identical with respondent's device. Petitioner never contended that the quoted language would not read on triangular-shaped gaskets and grooves arranged as in respondent's device. If the quoted language in original claims 2 and 3 reads on a

triangular gasket and groove, as held by the Patent Office, the same language in the claims of the patent must read on respondent's triangular gasket and groove.

Expert witness Trice, with fourteen years direct experience in research activities relating to pipe joints of the type in suit, testified and demonstrated (R. 190-195) that the language quoted above will literally read on respondent's device and this testimony was not shaken on cross examination. Respondent's expert witness Bradt, with no direct experience with pipe joints of the type in suit, testified on direct examination (R. 309-315) that the quoted language could not literally be read on respondent's device, but this testimony was severely shaken and partially modified on cross examination (R. 351-359). For example, he testified (R. 312) on direct examination that respondent's ring in the assembled joint was not squeezed or flattened. On cross examination (R. 357), he was requested to measure the degree of compression of respondent's gasket from the relaxed condition shown in Figure 6 of Defendant's Exhibit 28 (R. 892) to the assembled condition shown in Figure 7 of the same exhibit, and was forced to admit that the ring was squeezed or flattened to the extent of eighteen per cent in the solid portion.

The court of appeals statement that respondent's gasket does not move in the groove in response to fluid pressure is contrary to Trice's testimony (R. 189, 193), and not supported by Bradt's testimony (R. 359) with respect to Plaintiff's Exhibit 2 (R. 413), this being a copy of respondent's brochure which illustrates such movement and was stipulated by respondent to be accurate.

There was expert testimony (R. 195-198) in amplification of documentary exhibits to the effect that the gasket and groove in respondent's device function in every respect in accordance with the so-called O-ring principle. The testimony of petitioner's expert Trice on this point was forthright and unshaken. The testimony of respondent's

expert Bradt on this point was inconsistent (R. 300-308) and severely shaken (R. 347-359).

There was expert testimony (R. 197,198) that respondent's gasket and groove performs substantially the same functions in substantially the same way to obtain the same results as the gasket and groove of the joint defined by the claims in suit. Respondent offered no testimony to the contrary, and the trial court so found (Appendix A, Finding 37).

The pertinent findings of subsidiary fact which the court of appeals disregarded (Appendix A, Findings 33 through 42) are based upon and literally refer to the testimony, the documentary evidence and the credibility of the expert witnesses. These findings are clearly supported by the evidence, and the court of appeals' substituted judgment is manifestly contrary to the weight of the evidence.

APPENDIX D

February 27, 1962

Honorable Emett C. Choate
Judge, United States District Court
Federal Building
Miami, Florida

Re: Johns-Manville Corporation v. *Italit, Inc.*

Dear Judge:

Pursuant to the request of your Law Clerk, Mr. Al Schwitalla, a few days ago that Findings of Fact and Conclusions of Law be prepared in this case, Mr. C. Willard Hayes and his associates have prepared and sent to me suggested Findings of Fact and Conclusions of Law pursuant to Rule 52, two copies of which are enclosed for your consideration. Should you desire to discuss any detail of these proposed findings with counsel, Mr. Hayes will be glad to come down here for that purpose.

Mr. Schwitalla indicated that you were ruling with the plaintiff. Therefore, Mr. Hayes has prepared a suggested form of Interlocutory Judgment in accordance with 28 U.S.C. 1292(4) and 35 U.S.C. 284. Two copies of that are also enclosed.

We are sending copies of these papers to opposing counsel, in accordance with the certificates of service attached to the papers.

Respectfully yours,

HERBERT S. SAWYER /s/
For the Firm

11/vc
Enclosures

Copies to:

Dixon, DeJarnette, Bradford Williams, McKay & Kimbrell
Dade Federal Building
Miami, Florida

Pennie, Edmonds, Morton, Barrows & Taylor
247 Park Avenue
New York, New York

Cushman, Darby & Cushman
American Security Building
730 Fifteenth Street, N. W.
Washington 5, D. C.

Attention: C. Willard Hayes, Esquire
John A. McKinney, Esquire
J-M Research Center
Manville, N. J.

APPENDIX E

April 9, 1962

Mr. Al Schwitalla
Judge Choate's Chambers
Federal Building
Miami, Florida

Re: Johns-Manville v. Italit, Inc.

Dear Al:

I am handing you two copies of the Findings of Fact and Conclusions of Law and two copies of the Interlocutory Judgment.

We are returning the original copy of Findings of Fact and Conclusions of Law and the original copy of Interlocutory Judgment showing the changes, corrections, additions and deletions made by Judge Choate.

In addition, you will please find enclosed four copies of the Findings of Fact and Conclusions of Law and of the Interlocutory Judgment in four separate envelopes addressed to the various attorneys of record in the case, with sufficient stamps thereon, for your convenience in mailing the same after the copies now contained in said envelopes are conformed.

If you will be so kind as to call me when the Judge has signed these papers, I shall very much appreciate it.

Thanking you for your courtesy in the matter, I am

Sincerely yours,

HERBERT S. SAWYER s/
For the Firm

cc: C. Willard Hayes, Esq.
Cushman, Darby & Cushman
American Security Bldg.
730 Fifteenth St., N. W.
Washington 5, D. C.

9/vc
Enclosures

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 266

JOHNS-MANVILLE CORPORATION,

Petitioner,

v.

ITALIT, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI

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ACKERMAN PRESS, Phones BO 9-7107-8

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Statement

This is an ordinary patent infringement action. The patent relates to a pipe coupling—an art which both the Patent Office and the Court of Appeals recognized as highly developed (Petitio Appendix B, p. 6). The contested issues were the usual issues of validity and infringement of claims 1 and 2 of the patent in suit. Claim 1 is a specific claim, 446 words long. Claim 2 is dependent upon claim 1, adding 138 words to the restricting language of claim 1. Petitioner prevailed in the District Court upon both issues, the District Court adopting, with minor changes, findings and conclusions prepared by Petitioner's counsel.

The Court of Appeals affirmed the District Court on the finding of validity stating:

> "This finding of fact [Finding 20, Petition Appendix B, p. 5] cannot be set aside as clearly erroneous, and it warrants that the statutory requirements for patentability have been met" (Petition Appendix B, p. 6).

The Court of Appeals then proceeded to examine the history of the prosecution of the claims of the patent in suit. After a detailed comprehensive discussion of the claims and the manner in which they were amended and finally allowed, the Court concluded that the claims were not literally infringed by Respondent's coupling and that the language of the claims could not be expanded through the application of the doctrine of equivalents because of the nature of the art, the claim language and the history of the prosecution of the claims in the Patent Office. The Court of Appeals correctly followed the decision of this Court in *Keystone Co.* v. *Northwest Eng. Co.*, 294 U. S. 42 (1935) and reversed the District Court on the issue of infringement.

Petitioner now seeks by its petition to have this Court re-examine the issue of infringement.

Argument

There is no conflict between the decision of the Court of Appeals below and any decision of this Court. Instead, that Court followed the decision of this Court in the *Keystone* case, *supra*.

There is no conflict between the decision of the Court below and that of any other Court of Appeals.

The decision of the Court below turns upon the particular facts and circumstances regarding Respondent's

pipe coupling and does not involve any matters of public or general importance. Petitioner is in the same position as any other patent owner that has lost in the Court below.

The decision of the Court of Appeals is clearly correct on the basis of the history of the prosecution of the claims in the Patent Office, the language of the claims themselves and the stipulated structure of Respondent's pipe coupling. The relevant facts are discussed by the Court of Appeals (Petition Appendix B, pp. 6-12) in reaching the conclusion that the District Court "erred in finding that Claims 1 and 2 of the patent in suit have been infringed by the defendant, Italit" (Petition Appendix B, p. 12).

In "Question One" (Petition, p. 9 *et seq.*) Petitioner attempts to make a "constitutional" issue out of losing the case in the Court below. There certainly is no constitutional requirement that a Court of Appeals discuss in its opinion the *entire* evidence in making a decision. The Court of Appeals below discussed the relevant portions of the record and quite correctly concluded that the District Court had erred upon the issue of infringement. This can hardly give rise to a "constitutional" issue. Petitioner merely *lost* in the court below on a well-reasoned opinion discussing the relevant facts and applicable law.

"Question Two" (Petition, pp. 15-16) merely restates the same proposition as "Question One" without the "constitutional" issue.

In "Question Three" (Petition, pp. 17-19), Petitioner assumes that the Court of Appeals reversed the District Court because the findings and conclusions were prepared by counsel for the prevailing party. This is obviously not the fact because the Court below adopted the findings of the District Court on the validity issue as not clearly erroneous. The Court below found the findings of the District Court relating to the infringement issue clearly

erroneous upon the relevant facts which it discussed in its opinion. The applicable law regarding the fact finding function of the District Courts has been recently stated by this Court in *United States* v. *El Paso Gas Co.*, 376 U. S. 651 (1964) and by the Court of Appeals for the Fifth Circuit in *Louis Dreyfus & Cie.* v. *Panama Canal Company*, 298 F. 2d 733, 737-9 (5 Cir. 1962). These decisions are in complete harmony. The Court of Appeals in the decision below did not depart from these decisions.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the Petition for a writ of certiorari should be denied.

Respectfully submitted,

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330 Madison Avenue,
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PENNIE, EDMONDS, MORTON,
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Of Counsel.

New York, New York, August 6th, 1964.